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No. 93-1577

In The

Supreme Court of the United States

October Term, 1994

QUALITEX COMPANY,

Petitioner,

v.

JACOBSON PRODUCTS CO., INC.,

Respondent.

On Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

BRIEF OF AMICUS CURIAE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER

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BRIEF OF AMICUS CURIAE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER

INTRODUCTION

With the written consent of the parties pursuant to Supreme Court Rule 37.3,[1] *amicus curiae* International Trademark Association ("INTA") respectfully submits this brief in support of petitioner Qualitex Company ("Petitioner").

INTA urges the Court to reverse the judgment of the United States Court of Appeals for the Ninth Circuit

[1] The parties' letters of consent have been filed concurrently with this brief.

holding that color *per se*[2] is unregistrable and unprotectible as a matter of law under the United States Trademark Act (the "Lanham Act"), and ordering the cancellation of Petitioner's Trademark Registration No. 1,633,711 for the green-gold color for dry cleaning press pads. *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297 (CA9), *cert. granted*, ___ U.S. ___, 115 S. Ct. 40, 63 U.S.L.W. 3214, 3255 (1994). For the reasons discussed *infra*, INTA believes that the holding of the Court of Appeals judicially created an absolute prohibition on the registration of color *per se* where none was enacted, or intended, by Congress.

STATEMENT OF INTEREST OF THE AMICUS CURIAE

INTA, founded in 1878 as The United States Trademark Association ("USTA"), is a not-for-profit corporation of more than 2,700 members having a special interest in trademarks. INTA's members include trademark owners, advertising agencies, and law firms from the United States and foreign countries, including some of the world's foremost corporations. These members form an important segment of the United States' business community, and they and their counsel have substantial expertise in trademark law.

INTA's corporate members spend millions of dollars each year in the development, registration, and protection of their trademarks in the United States. All INTA members

[2] As used in this brief, the term color *per se* refers to a single color or single shade of color, without any additional elements such as designs. *See, e.g., NutraSweet Co. v. Stadt Co.*, 917 F.2d 1024, 1027 n.6 (CA7 1990), *cert. denied*, 499 U.S. 983 (1991).

share an interest in protecting the integrity of the United States' trademark system through encouraging the coherent and consistent interpretation of the Lanham Act and judicial treatment of federally-registered trademarks.

INTA has been instrumental in making recommendations and providing assistance to Congress in connection with the Lanham Act, most recently through the active participation of USTA's Trademark Review Commission in the development and enactment of the Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935, (codified at 15 U.S.C. § 1051, *et seq.* (1988)), the most significant amendment of the Lanham Act since its passage in 1946. See 134 Cong. Rec. S16974 (daily ed. October 20, 1988) (statement of Sen. DeConcini). INTA also has participated in the past as an *amicus curiae* in trademark cases before this Court, *e.g., Two Pesos, Inc. v. Taco Cabana International, Inc.*, ___ U.S. ___, 112 S. Ct. 2753 (1992), and in many lower courts. The Court previously granted INTA's motion for leave to file a brief as an *amicus curiae* in support of the petition for a writ of *certiorari*. *Qualitex*, ___ U.S. ___, 115 S. Ct. 40, 63 U.S.L.W. 3214, 3255 (1994).

The Courts of Appeals conflict sharply on the question on which *certiorari* was granted. The Seventh and Ninth Circuits have held that color *per se* is unregistrable and unprotectible as a matter of law and that no registration of color *per se* as a mark could ever properly be issued by the Patent and Trademark Office ("PTO"), the administrative agency to whom Congress has delegated authority under the Lanham Act to register trademarks. *NutraSweet Co. v. Stadt Co.*, 917 F.2d 1024 (CA7 1990) (affirming summary judgment that blue was not protectible as a trademark for artificial sweetener), *cert. denied*,

499 U.S. 983 (1991); *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297 (CA9), *cert. granted*, ___ U.S. ___, 115 S. Ct. 40, 63 U.S.L.W. 3214, 3255 (1994).

The Federal and Eighth Circuits, however, have held that color *per se* is registrable when it functions as a trademark, and the statutory requirements for registration otherwise are satisfied. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (CA Fed 1985) (reversing refusal to register pink as a trademark for fiberglass insulation); *Master Distributors, Inc. v. Pako Corp.*, 986 F.2d 219 (CA8 1993) (reversing summary judgment that blue was not protectible as a trademark for splicing tape); *see also Brunswick Corp. v. British Seagull Ltd.*, ___ F.3d ___, 32 U.S.P.Q.2d (BNA) 1120 (CA Fed 1994) (following *Owens-Corning*, but affirming PTO's refusal to register black as a trademark for outboard motors because black was *de jure* functional for those goods).

The refusal of the Seventh and Ninth Circuits to permit the registration of color *per se* precludes a consistent nationwide treatment of color trademarks, even though Congress has determined that all federally-registered trademarks "should receive nationally the greatest protection that can be given them." *Park 'n Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 193 (1985). INTA submits this brief to express its view that the Federal and Eighth Circuits properly give effect to the intent of Congress as expressed in the Lanham Act, and to urge the Court to reject the contrary views of the Ninth Circuit Court of Appeals in this case and in the authorities upon which the Court of Appeals relied.

SUMMARY OF THE ARGUMENT

Any "trademark by which the goods of the applicant may be distinguished from the goods of others" is eligible for federal registration unless it is excluded specifically by § 2 of the Lanham Act, which makes no mention of color.

While acknowledging that registration of color *per se* is not prohibited by the terms of the Lanham Act, the Court of Appeals held that color *per se* is unregistrable as a matter of law, and ordered the cancellation of Petitioner's federal registration, without considering the statutory definition of "trademark" or the legislative history relevant to its interpretation. The Court of Appeals' absolute prohibition on registration is inconsistent with the language and legislative history of the Lanham Act, which reflect the policy determination by Congress that color *per se*, like any subject matter that functions as a trademark, may be registered when the statutory requirements for registration are satisfied.

The federal registration process created by Congress requires the PTO and the courts to determine on a case-by-case basis whether a particular color functions as a trademark and is thus registrable. This determination properly is made by applying traditional principles of trademark law within the framework of the statute.

ARGUMENT

The Lanham Act Does Not Prohibit Registration Of Color *Per Se* As A Trademark

The District Court in the case below "ruled that [Respondent] infringed on [Petitioner's] registered trademark, the green-gold color of the press pads." *Qualitex*, 13 F.3d at 1301. In reviewing that judgment, the Court of Appeals began by acknowledging the evidentiary effect of Petitioner's certificate of federal registration, which "shift[ed] the burden of proof to the contesting party . . . [to] introduce sufficient evidence to rebut the presumption of the holder's right to protected use." *Id.* The Court of Appeals then approved the District Court's "findings of facts [which were] reviewed for clear error." *Id.*

The Court of Appeals thereafter undertook a *de novo* review of the legal issue of "[w]hether color *per se* qualifies for trademark protection," *id.*, and ordered the cancellation of Petitioner's registration without disputing the propriety of the findings by the PTO and the District Court that the green-gold color in fact functioned as Petitioner's trademark and was properly registered.[3]

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[3] The issue of whether the PTO and the District Court properly made the determination of registrability is not before the Court on the writ of *certiorari*, and INTA takes no position on its proper resolution. It appears, however, that given the limited scope of the Court of Appeals' review of the District Court's findings pursuant to Rule 52(a) of the Federal Rules of Civil Procedure, *see Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 855 (1982), it will not be necessary for the Court of Appeals to reconsider the issue on remand. In affirming the District Court's judgment that respondent had engaged in unfair competition through the sale of green-gold press pads, the Court of Appeals found, *inter alia*, that "it was not error for the district court to conclude that 'there is no competitive need for the green-gold color, since other colors are equally usable' and that 'the range of tones of available distinctive suitable colors . . . is in the hundreds if not thousands.' " *Qualitex*, 13 F.3d at 1304.

The cancellation of Petitioner's registration resulted from the Court of Appeals' rejection of the reasoning of the Federal and Eighth Circuits in *Owens-Corning* and *Master Distributors*, respectively, and its adoption of the views expressed by the Seventh Circuit in *NutraSweet* and by the dissent in *Owens-Corning*. INTA submits that the Court of Appeals erred because it did not examine the relevant statutory text and legislative history, which make clear the mandate of Congress that the PTO is to register color *per se* when an applicant for registration proves that a particular color functions as its trademark.

I. Congress Has Not Excluded Color *Per Se* From The Trademarks That Are Registrable Pursuant To § 2 Of The Lanham Act

Pursuant to § 2 of the Lanham Act, a trademark "'by which the goods of the applicant may be distinguished from the goods of others' . . . must be registered unless otherwise disqualified." *Two Pesos, Inc. v. Taco Cabana International, Inc.*, ___ U.S. ___, 112 S. Ct. 2753 (1992) (citation omitted). At the outset of its analysis, the Court of Appeals correctly held that Congress had not designated color *per se* as "otherwise disqualified" from registration:

> Registration of mere color is not explicitly barred by the Lanham Act, which provides that '[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration' . . . unless one of the specific exceptions to registrability set forth in 15 U.S.C. § 1052 applies. Color is not listed as an exception.

Qualitex, 13 F.3d at 1301 (citation omitted).

Having held that color *per se* was not specifically excepted from eligibility for registration, the Court of Appeals was required by the structure of § 2 of the Act to determine whether Congress excluded color *per se* from the subject matter that may function as a "trademark by which the goods of the applicant may be distinguished from the goods of others." 15 U.S.C. § 1052. If color *per se* was not excluded, the Court of Appeals was obligated to go no further in its analysis of the issue. "If the intent of Congress is clear, that is the end of the matter; for [a] court . . . must give effect to the unambiguously expressed intent of Congress." *Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 842-43 (1984).

II. Congress Has Not Excluded Color *Per Se* From The Subject Matter That Can Function As A "Trademark" Within The Meaning Of §§ 2 And 45 Of The Lanham Act

The necessary starting point for the proper inquiry is the definition of "trademark" in § 45 of the Act, which "includes *any* word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify

and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127 (emphasis added). The statutory definition does not exclude any subject matter, and the language "any . . . symbol, or device" is sufficiently inclusive on its face to include all forms of non-verbal subject matter that can "identify and distinguish" goods and "indicate the source of the goods." *Id.*

The current definition of "trademark" was enacted in the Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935, (codified at 15 U.S.C. § 1051, *et seq.* (1988)), three years after the Federal Circuit's decision in *Owens-Corning*. In *Owens-Corning*, the PTO's Trademark Trial and Appeal Board had "conclu[ded] that there is no inherent bar to trademark registration of the color of goods," *Owens-Corning*, 774 F.2d at 1118, but had affirmed the examining attorney's refusal of registration on the ground that the applicant had failed to show that the color pink had acquired distinctiveness pursuant to § 2(f) of the Act as a trademark for the applicant's goods. *See In re Owens-Corning Fiberglas Corp.*, 221 U.S.P.Q. (BNA) 1195 (TTAB 1984), *rev'd*, 774 F.2d 1116 (CA Fed 1985).

The Federal Circuit reversed and ordered the PTO to register the color pink because the applicant had made a sufficient showing of acquired distinctiveness. The court reviewed the history of the Lanham Act and found that one of the Act's original purposes was to liberalize the registration process by "dispensing with 'mere technical prohibitions and arbitrary provisions' and modernizing

the trademark statutes 'so that they will conform to legitimate present-day business practice.' " *Owens-Corning*, 774 F.2d at 1119 (quoting *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360 (CCPA 1973)). "Under the Lanham Act trademark registration became available to many types of previously excluded indicia," *Owens-Corning*, 774 F.2d at 1119, including containers, product configurations, sounds, scents, slogans, and other non-traditional subject matter. By the time of the Federal Circuit's decision, it had "become established that the color of goods, as other indicia, may serve as a trademark if the statutory requirements are met." *Id.* at 1122.

On the basis of the *Owens-Corning* decision, the PTO determined that "color can function as a trademark if it is used on the goods in the manner of a trademark and if it is perceived by the purchasing public as identifying and distinguishing the goods on which it is used and indicating their source." *Trademark Manual of Examining Procedure*, § 1202.04(e), at 1202-13 (2d ed. 1993). The PTO directed its examining attorneys to register a color when the applicant proved that the color "ha[d] become distinctive of the applicant's goods in commerce." *Id.*

Against this background, in the Trademark Law Revision Act of 1988, Congress chose not to disturb the PTO's practice of registering color marks, pursuant to *Owens-Corning*, when it broadened the original definition of "trademark" in the Lanham Act "to reflect contemporary marketing practices and to make clear a trademark's function of distinguishing the goods of one person from those of another." S. Rep. No. 100-515, 100th Cong., 2d Sess. 44 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5607. "The revised definition intentionally retain[ed] . . . the

words 'symbol or device' *so as not to preclude the registration of colors*, shapes, sounds or configurations where they function as trademarks." *Id.* (emphasis added).[4]

Congress plainly did not exclude color *per se* from the definition of "trademark" when it revised the Lanham Act in 1988. To the contrary, the foregoing legislative history demonstrates that Congress meant the language "any . . . symbol, or device" to encompass any non-traditional subject matter – including color – which the PTO determines "identif[ies] and distinguish[es] [a person's] goods" and "indicate[s] the source of the goods." 15 U.S.C. § 1127. The PTO's interpretation of the Lanham Act as permitting the registration of color unquestionably reflects what the Court has characterized as "a plausible construction of the plain language of the statute [which] does not otherwise conflict with Congress' expressed intent." *Rust v. Sullivan*, 500 U.S. 173, 184 (1991).

The Court of Appeals did not address the statutory language or the legislative history relevant to its interpretation; instead, it simply "conclude[d] that the better rule is that a trademark should not be registered for color alone," *Qualitex*, 13 F.3d at 1302, and ordered the cancellation of Petitioner's registration. In doing so, the Court of

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[4] The quoted language in the Senate Report was taken almost *verbatim* from the United States Trademark Association Trademark Review Commission, *Report and Recommendations to U.S.T.A. President and Board of Directors*, reported at 77 Trademark Reporter 375 (1987), in which the Commission "determined that the terms 'symbol, or device' should not be deleted or narrowed to preclude registration of such things as a color, shape, smell, sound, or configuration which functions as a mark." 77 Trademark Reporter at 421.

Appeals ignored its obligation to give "substantial deference . . . to the interpretation of the authorizing statute by the agency authorized with administering it," *Rust*, 500 U.S. at 184, and engrafted onto the Act an absolute prohibition on the registration of color that is supported by neither the text of the statute nor its history.

III. The Determination Of Whether A Particular Color Is Registrable Must Be Made On A Case-by-Case Basis

Lacking support in the text or history of the statute for what it termed the "better rule" that color *per se* is never registrable, the Court of Appeals relied upon the so-called "color depletion" theory, under which "no person should have a monopoly on a primary color." *Qualitex*, 13 F.3d at 1302.[5] The Court of Appeals apparently viewed that theory as compelling – or at least justifying – its determination of the registrability of color *per se* as a matter of law. This view is wholly at odds with the Congressional mandate that the registrability of any otherwise eligible mark – including a single color – must be determined as a factual matter in the statutory registration process.

The Federal Circuit's recent decision in *Brunswick*, ___ F.3d ___, 32 U.S.P.Q.2d (BNA) 1120, illustrates that the

[5] Interestingly, only a few months before the decision under review, a different panel of the Court of Appeals noted that "[i]t is open to question whether the color depletion theory . . . is still persuasive." *International Jensen Inc. v. Metrosound U.S.A. Inc.*, 4 F.3d 819, 823 (CA9 1993) (affirming denial of preliminary injunction against use of the color blue on car stereo loudspeakers).

Court of Appeals should have used the color depletion theory simply as one factor in its review of the factual determinations by the PTO and the District Court that the green-gold color functioned as Petitioner's trademark. In *Brunswick*, the applicant applied to register the color black for outboard motors. Two competitors of the applicant challenged the application by filing an opposition proceeding before the Trademark Trial and Appeal Board.[6] The opposers demonstrated that the applicant had not made exclusive use of the color black for outboard motors, and that there was a competitive need to use black in the industry because black insured the color compatibility of outboard motors with boats of different colors and made the motors appear smaller in size. *See British Seagull Ltd. v. Brunswick Corp.*, 28 U.S.P.Q.2d (BNA) 1197, 1199 (TTAB 1993), *aff'd*, ___ F.3d ___, 32 U.S.P.Q.2d (BNA) 1120 (CA Fed 1994).

The Trademark Trial and Appeal Board sustained the opposition and refused registration on the ground that

[6] When the application at issue in *Brunswick* was approved by the PTO examiner for registration, it was published for opposition, pursuant to § 12 of the Lanham Act, 15 U.S.C. § 1062, to allow "[a]ny person who believe[d] that he would be damaged by the registration of [the] mark on the principal register" to file a notice of opposition to registration of the mark. 15 U.S.C. § 1063(a). The opposition process is the mechanism by which "Congress [has] wisely provided that anyone who believed that he would be damaged by an application already approved by the Trademark Office [can] commence an adversary, *inter partes* proceeding against the applicant, with an administrative tribunal as the court of first resort." 3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20.01[1] at 20-7 (3d ed. 1992).

black did not function as the applicant's trademark, but was instead *de jure* functional. *Id.* The Board found that the color depletion theory "could be a factor to consider under appropriate circumstances. . . . [W]hen we consider whether a color is functional we must consider whether alternative colors are available in order to avoid the fettering of competition. If competition will be hindered, the color in question is de jure functional." *Id.* at 1199 (citations omitted).

In affirming the PTO's judgment as not clearly erroneous, the Federal Circuit agreed, holding that the "[color depletion] theory is not faulted for appropriate application, but following [the] passage of the Lanham Act courts have declined to perpetuate its *per se* prohibition which is in conflict with the liberating purposes of the Act." *Brunswick*, ___ F.3d at ___, 32 U.S.P.Q.2d at 1123 (quoting *Owens-Corning*, 774 F.2d at 1120) (original emphasis deleted). "The functionality limitation on trademark protection properly subsumes any lingering policy concerns embodied in the 'color depletion theory.' The theory is not a *per se* bar to registration of color marks." *Id.*

The *Brunswick* court held that no special rules apply to the registrability of color *per se*. "Rather, traditional trademark policies, including the functionality limitation, set the boundaries for color mark registration. Thus, if the use of color on the applicant's goods serves a non-trademark purpose that hinders competition, the de jure functionality doctrine precludes trademark protection. Only in that sense does the 'color depletion theory' have any viability." *Id.*

INTA submits that the Federal Circuit's analysis in *Brunswick*, and its application of "traditional trademark policies," are correct and illustrate the proper role of a reviewing court in the statutory scheme of registration. Congress has delegated to the PTO the duty of determining whether all marks that have not been specifically excluded from eligibility for registration otherwise meet the statutory requirements for registration. Because Congress has established no special rules regarding color marks, much less prohibited their registration, the determination of the registrability of a particular color necessarily must be made through the examination of the application in the PTO and on the basis of the factual record in any challenge to registration of the color, whether before the Trademark Trial and Appeal Board or in civil litigation involving the mark. An appellate court must defer to the factual findings of the PTO and the trial courts unless they are clearly erroneous or are based upon an incorrect application of the statute. The *Brunswick* court did just that, thus implementing the intent of Congress.

The task for the Court of Appeals below was to determine whether the PTO and the District Court improperly applied the Lanham Act in the determination of registrability, or clearly erred in finding that the green-gold color functioned as Petitioner's "trademark" within the meaning of §§ 2 and 45 of the Lanham Act. The Court of Appeals disregarded this limited role and chose instead to impose its own view of desirable federal trademark policy. Clearly this was improper, as Congress already had expressed in the Lanham Act its decision that color *per se* can be registered federally when the PTO

determines that the statutory requirements for registration are met. The Court of Appeals was bound to respect and give full effect to the policy determination reflected in the statute:

> [F]ederal judges – who have no constituency – have a duty to respect legitimate policy choices made by those who do. The responsibilities for assessing the wisdom of such policy choices and resolving the struggle between competing views of the public interest are not judicial ones: "Our Constitution vests such responsibilities in the political branches."

Chevron, 467 U.S. at 866 (citation omitted).

Unless and until Congress decides otherwise, and amends the Lanham Act accordingly, color *per se*, like any other type of trademark, is registrable when the statutory requirements are satisfied.

CONCLUSION

For all of the foregoing reasons, the Court should reverse the judgment of the Court of Appeals ordering cancellation of Petitioner's federal registration.

Respectfully submitted,

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